

## **REMARKS**

### **1. Summary of Office Action**

In the office action mailed September 22, 2004, the Examiner rejected claims 1, 2, 6-9, 14-18 and 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,330,454 (Verdonk). Further, the Examiner rejected claims 3-5, 10-13 and 19 under 35 U.S.C. § 103(a) as being obvious over a combination of Verdonk and U.S. Patent No. 6,716,101 (Meadows).

### **2. Amendments and Pending Claims**

As shown above, Applicant has amended claims 1 and 16. Therefore, now pending in this application are claims 1-20, of which claims 1 and 16 are independent and the remainder of claims are dependent. Applicant has amended claims 1 and 16 to include elements relating to the method of establishing the call to the mobile.

### **3. The Claimed Invention**

Applicant's invention is directed to a method of locating an idle mobile unit. The invention includes initiating a call to the mobile unit using a service node. The call is originated from the service node after it receives information regarding the phone number of the lost mobile, and (in some embodiments) receiving authorization that the requester is entitled to receive the tracking information. The call from the service node to the mobile is performed using existing messaging, including having the home MSC locate the mobile, which involves receiving a routing alias in the form of a TLDN message from the serving MSC, and transmitting an ISUP message from the home MSC to the serving MSC. The serving MSC, then, recognizing the call to have originated from a service node, determines that the call is to generate location information. The information may then be provided to the service node in the form of a facilities available message (FAVAIL). The service node then informs the user of the location.

#### **4. Response to § 102 Rejections**

As noted above, the Examiner rejected claims 1, 2, 6-9, 14-18 and 20 under 35 U.S.C. § 102(e) as being anticipated by Verdonk. Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicant respectfully traverses the rejections of pending claims 1, 2, 6-9, 14-18 and 20 because Verdonk does not disclose or suggest each and every element as recited in any of these claims.

Specifically, Verdonk uses a different signaling scheme to obtain location information than what is set forth in the independent claims 1 and 16. Verdonk uses a modified form of a location request message sent from the home MSC to the HLR. Verdonk, col. 5, lines 21-26. The message indicates that location information should be returned. As such, the HLR sends these location request parameters to the serving MSC, thereby informing the serving MSC not to return a TLDN, but rather to provide the location information directly. Verdonk, col. 5, lines 26-29.

In contrast, Applicant's pending claims set forth a method that explicitly requires a routing alias to be returned. The routing alias allows the call from the SCP to be routed to the serving MSC. It is at this point that the serving MSC identifies the call as a location request. Verdonk does not teach a method of locating a mobile station, wherein a service node initiates a call to the mobile, including the steps of receiving a routing alias. Verdonk specifically teaches that a TLDN is not returned, but that location information is returned. At best, Verdonk discloses a method of locating a mobile using a modified location request message to inform a serving MSC that location information is being requested.

In that Verdonk does not describe each and every element of Applicant's independent

claims 1 and 16, Applicant submits that Verdonk does not anticipate claims 1 and 16.

Furthermore, 37 CFR 1.75(c) states "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." Since dependent claims 2-15 and 18-20 incorporate by reference either claim 1 or claim 16 and since Applicant contends that claims 1 and 16 are not anticipated by Verdonk, Applicant submits that Verdonk does not anticipate any of the dependent claims. Therefore, Applicant submits that pending claims 1-20 are in condition for allowance.

#### **5. Response to § 103 Rejections**

The Examiner rejected claims 3-5, 10-13 and 19 under 35 U.S.C. § 103(a) as being obvious over a combination of Verdonk and Meadows. According to M.P.E.P § 2143, in order to establish a prima facie case of obviousness of a claimed invention by applying a combination of references, the prior art must teach or suggest all of the claim limitations.


As described above, the independent claims include limitations that are not found in the Verdonk reference. Applicants have not found those limitations in the Meadows reference. Because the combination of Verdonk and Meadows does not teach or suggest all of the claim limitations of Applicant's claims, Applicants respectfully submits that claims 3-5, 10-13 and 19 are in condition for allowance.

#### **6. Conclusion**

Accordingly, Applicant respectfully submits that all pending claims 1-20 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney, at 312-913-3305.

Respectfully submitted,  
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Date: December 22, 2004

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